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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,371	10/07/2003	Anthony C. Fascenda	62922.3	4292

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EXAMINER

CHEN, SHIN HON

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/679,371

Applicant(s)

FASCENDA, ANTHONY C.

Examiner

Shin-Hon Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 13-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/7/05</u> | 6) <input type="checkbox"/> Other: _____  |

*HC*

**DETAILED ACTION**

1. Claims 1-11 and 13-28 have been examined.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-11, 13, and 19-28 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Pitchenik et al. U.S. Pat. No. 6397328 (hereinafter Pitchenik).
3. As per claim 1, Pitchenik discloses a method of authenticating computing devices on a communications network comprising the steps of : receiving a first challenge from a computing device, wherein said first challenge comprises an encrypted first random number and a unique identifier associated with said computing device (Pitchenik: column 2 line 40 – column 3 line 28; column 4 lines 32 – 67); obtaining a first secret cryptographic key associated with said unique identifier (Pitchenik: column 2 line 40 – column 3 line 28; column 4 lines 32 – 67); generating a second random number (Pitchenik: column 2 line 40 – column 3 line 28; column 4 lines 32 – 67); decrypting said first random number with said first secret cryptographic key (Pitchenik: column 2 line 40 – column 3 line 28; column 4 lines 32 – 67); encrypting said second random number with said first secret cryptographic key (Pitchenik: column 2 line 40 – column 3 line 28;

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column 4 lines 32 – 67); and transmitting a second challenge to said computing device, wherein said second challenge comprises said encrypted said second random number (Pitchenik: column 2 line 40 – column 3 line 28; column 4 lines 32 – 67).

4. As per claim 19, Pitchenik discloses a method of authenticating computing devices on a communications network comprising the steps of: receiving a first challenge from a computing device, wherein said first challenge comprises a first random number and a unique identifier associated with said first secret cryptographic key (Pitchenik: column 2 line 34 – column 3 line 3); and transmitting a second challenge to said computing device, wherein said second challenge comprises said encrypted first random number and said second random number (Pitchenik: column 2 line 34 – column 3 line 3).

5. As per claim 2 and 20, Pitchenik discloses the method of claims 1 and 19 respectively. Pitchenik further discloses wherein said unique identifier is a serial number of a physical token installed at said computing device (Pitchenik: column 3 line 60 – column 4 line 10: the identification number and associated key within the device).

6. As per claim 3 and 21, Pitchenik discloses the method of claims 2 and 20 respectively. Pitchenik further discloses wherein said step of obtaining a first secret cryptographic key comprises the step of retrieving a pre-stored record associated with said serial number, wherein said record comprises said first secret cryptographic key (Pitchenik: column 2 line 40 – column 3

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line 28; column 4 lines 32 – 67; column 3 line 60 – column 4 line 10: the keys are stored in the device and the host PC respectively).

7. As per claim 4 and 22, Pitchenik discloses the method of claims 3 and 21 respectively. Pitchenik further discloses wherein said step of obtaining a first secret cryptographic key comprises the step of receiving a key database file comprising a number of records, wherein each record is associated with a unique physical key token and comprises a unique secret cryptographic key and a unique serial number (Pitchenik: column 2 line 40 – column 3 line 28; column 4 lines 32 – 67; column 3 line 60 – column 4 line 10: the keys are stored in the device and the host PC respectively).

8. As per claim 5 and 23, Pitchenik discloses the method of claims 4 and 22 respectively. Pitchenik further discloses wherein said unique secret cryptographic key is created from a random number generated at initialization of said token (Pitchenik: column 3 line 60 – column 4 line 24).

9. As per claim 6 and 24, Pitchenik discloses the method of claims 1 and 19 respectively. Pitchenik further discloses the method comprising the steps of: decrypting said first challenge with a network receive cryptographic key; and encrypting said second challenge with a network send cryptographic key (Pitchenik: column 2 line 40 – column 3 line 28; column 4 lines 32 – 67; column 3 line 60 – column 4 line 10: the key pair).

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10. As per claim 7, Pitchenik discloses the method of claim 3. Pitchenik further discloses wherein said step of decrypting said encrypted first random number results in a first value, and further comprising the step of disallowing said computing device to communicate with other computing devices on said network if said first value is a null value (Pitchenik: column 4 line 33 – column 5 line 4: the authentication technique can be applied to both parties).

11. As per claim 8, Pitchenik discloses the method of claim 7. Pitchenik further discloses wherein allowing said computing device to communicate with other computing devices on said network if said first value is not a null value (Pitchenik: column 4 line 33 – column 5 line 4: the authentication technique can be applied to both parties).

12. As per claim 9, Pitchenik discloses the method of claim 7. Pitchenik further discloses the method comprising the step of decrypting said second challenge with a network receive cryptographic key (Pitchenik: Pitchenik: column 2 line 40 – column 3 line 28; column 4 lines 32 – 67; column 3 line 60 – column 4 line 10: the key pair).

13. As per claim 10, Pitchenik discloses the method of claim 8. Pitchenik further discloses the method comprising the step of decrypting said encrypted second random number with a second secret cryptographic key (Pitchenik: column 2 line 40 – column 3 line 28; column 4 lines 32 – 67; column 3 line 60 – column 4 line 10).

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14. As per claim 11, Pitchenik discloses the method of claim 10. Pitchenik further discloses wherein said second secret cryptographic key is stored within said physical token (Pitchenik: column 2 line 40 – column 3 line 28; column 4 lines 32 – 67; column 3 line 60 – column 4 line 10).

15. As per claim 13, Pitchenik discloses a communications system comprising: a number of computing devices, and at least one authentication device, wherein each client device or authentication device includes a unique tamper-resistant physical token comprising a random number generator, a unique secret cryptographic key, and a unique serial number (Pitchenik: column 2 line 40 – column 3 line 28; column 4 lines 32 – 67; column 3 line 60 – column 4 line 10).

16. As per claim 25, Pitchenik discloses the method of claim 21. Pitchenik further discloses the method comprising the steps of: receiving a third challenge from said computing device, wherein said third challenge comprises said second random number encrypted with a second secret cryptographic key (Pitchenik: column 2 line 34 – column 3 line 29); decrypting said encrypted second random number with said first secret cryptographic key (Pitchenik: column 2 line 34 – column 3 line 29); and comparing said decrypted second random number to said second random number to determine if a match exists (Pitchenik: column 2 line 34 – column 3 line 29).

17. As per claim 26, Pitchenik discloses the method of claim 25. Pitchenik further discloses wherein if a match exists between said decrypted second random number and said second

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random number, allowing said computing device to communicate with other computing device on said network, otherwise if a match does not exist, disallowing said computing device to communicate with other computing devices on said network (Pitchenik: column 2 line 34 – column 3 line 29).

18. As per claim 27, Pitchenik discloses the method of claim 25. Pitchenik further discloses the method comprising the step of decrypting said third challenge with a network receive cryptographic key (Pitchenik: column 2 line 34 – column 3 line 29).

19. As per claim 28, Pitchenik discloses the method of claim 25. Pitchenik further discloses wherein said second secret cryptographic key is stored within said physical token (Pitchenik: column 2 line 34 – column 3 line 29 and column 3 line 60 – column 4 line 10).

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 14-16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitchenik in view of Kimura U.S. Pub. No. 20010048744 (hereinafter Kimura).



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22. As per claim 14, Pitchenik discloses the system of claim 13. Pitchenik does not explicitly disclose wherein each client device or authentication device further includes a wireless communications transceiver to communicate on a wireless network. However, it would have been obvious to one having ordinary skill in the art to apply the authentication method to any communication environment including wireless network. Alternatively, Kimura discloses access point authentication method and applying challenge response and random numbers to authenticate mobile terminals within wireless LAN that complies with IEEE 802.11 (Kimura: [0038]-[0040]). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to apply the authentication technique to any communication system. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Kimura within the system of Pitchenik because it prevents unauthorized access from mobile stations of malicious intruders in a radio-based wireless LAN network.

23. As per claim 15, Pitchenik as modified discloses the system of claim 14. Pitchenik as modified further discloses wherein said wireless network is Wi-Fi network (Kimura: figure 5 and [0004], [0035]-[0040]).

24. As per claim 16, Pitchenik as modified discloses the system of claim 15. Pitchenik as modified further discloses wherein said authentication device is an access point (Kimura: [0039]-[0040] and figure 2).

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25. As per claim 18, Pitchenik as modified discloses the system of claim 16. Pitchenik as modified further discloses wherein said access point includes a database file comprising said serial numbers and secret cryptographic keys associated with said tokens (Pitchenik: column 3 line 60 – column 4 line 10; Kimura: [0004], [0035]-[0040]).

26. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pitchenik in view of Kimura and further in view of Shteyn U.S. Pub. No. 20040203590 (hereinafter Shteyn).

27. As per claim 17, Pitchenik as modified discloses the system of claim 13. Pitchenik as modified does not explicitly disclose wherein each tamper-resistant physical token is installed via a USB interface. However, Shteyn discloses using a dongle installed via a USB to secure communications in a wireless network (Shteyn: [0027]). It would have been obvious to one having ordinary skill in the art to store identifications information and cryptographic key into the hardware key while authentication takes place between a mobile terminal and an access point. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Shteyn within the combination of Pitchenik-Kimura because dongle is well known in the art for providing security parameters within network.

### ***Response to Arguments***

28. Applicant's arguments filed on 3/23/05 have been fully considered but they are not persuasive.

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As per claim 1 and 19, applicant argues that the Pitchenik reference does not disclose generating a second random number. However, Pitchenik discloses that sending a second encrypted message to the PSD (Pitchenik: column 4 lines 35-59: the second encrypted message). The second random number is generated by decrypting the first encrypted message. Therefore, applicant's argument is respectfully traversed.

As per claim 13, applicant argues that Pitchenik reference does not disclose a tamper resistant physical token. However, Pitchenik discloses that the cryptographic key and unique ID are stored within the postage security device, which is a tamper resistant device. Therefore, the tamper resistant physical token is included in the postage security device ready for authentication. Also, Shteyn reference discloses using a dongle for authentication purposes, the combination of Shteyn within the system of Pitchenik would produce a hardware key with the features discloses by Pitchenik.

### ***Conclusion***

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Hon Chen whose telephone number is (571) 272-3789. The examiner can normally be reached on Monday through Friday 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shin-Hon Chen  
Examiner  
Art Unit 2131

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